specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention." (see page 2–3 of the Office Action). The Examiner asserts that the "specification does not describe how to determine what products most closely correspond to other products." (see lines 3–4 on page 3 of the Office Action). The Examiner then provides a lengthy discussion of the was in which configures could be classified as closely corresponding to products found to be present in inventory. (see page 3 of the Office Action).

Applicants respectfully draw the Examiner's attention to the passage within the specification from the bottom of page 24 through and including page 26. In this passage, the application teaches the use of a "closest match button" which produces a listing of the inventory which most closely matches the options selected during the configuration process. This process uses a value column used by a value solver to find a solution which most closely satisfies the user's preferences. The discussion in this passage will allow one skilled in the art to make and use the claimed invention WITHOUT UNDUE EXPERIMENTATION.

While this passage from the specification does not expressly state how one skilled in the art would generate a ranked listing for the matching options and what threshold might be used to specify the matching options, the generation of any number of matching values which would permit one skilled in the art to make and use the invention are known in the art. All database matching operations, such as those used in web–based search engines for example, know how to generate a match value based upon non–exact matches between a query and a data base. One skilled in the art could make and use software as claimed in this application which determines the products in inventory which most closely correspond to the configured product.

REJECTIONS UNDER 35 USC 103

Claims 1–10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dworkin (US 4,992,940) in view of Gupta, et al. (US 5,825,651) in further view of Winning Technologies. In each of these rejections, the Examiner acknowledges that neither Dworkin nor Gupta alone teach the invention recited within Claims 1–10. The Examiner does, however, assert that the combination of the teachings from Dworkin and Gupta together teach the inventions recited within Claims 1–10. Importantly, the Examiner acknowledges that these two references themselves do not provide motivation to combine these references to construct a proper rejection under 35 USC 103. The Examiner cites the article dated December 16, 1996 regarding Winning

Technologies to provide the motivation to combine the teachings from Dworkin and Gupta to reject all of the claims in this application.

These rejections fail because the Applicants both conceived and reduced to practice the inventions recited in Claims 1–10 before the publication of the Winning Technologies article. (see paragraghs 4–6 of the Inventors' Declaration attached hereto and incorporated herein). Without the teachings from the Winning Technologies article, no proper motivation exists to combine the teachings of Dworkin and Gupta as stated in the Office Action. As such, the rejection of Claims 1–10 should be withdrawn.

Additionally, these rejections also fail because the Applicants both conceived and reduced to practice the inventions recited in Claims 1–10 before the filing of the Gupta patent application. (see paragragh 7 of the Inventors' Declaration attached hereto and incorporated herein). The rejection of Claims 1–10 should be withdrawn because the Gupta patent may not be used as prior art against this application.

CONCLUSION

In view of the above arguments, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejections are kindly requested. Allowance of all pending claims is respectfully submitted.

Respectfully submitted,

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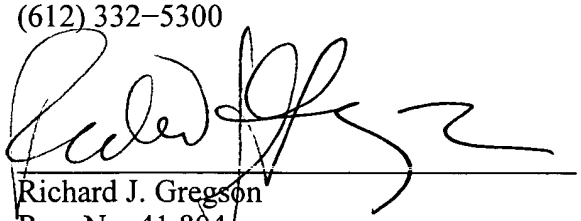

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